

Jeremy Dennis Bartlett  
Appln. No. 10/031,064  
Amendment Under 37 C.F.R. § 1.114(c)

### **REMARKS**

Applicant submits the present amendment in response to the final Office Action dated August 3, 2005, in which the Examiner rejected claims 1-12. Claims 1-13 are pending in the present Application. Claim 13 has been added. Support for new Claim 13 is provided by, for example, Figs. 3, 5B-5E and 6 of the specification. Claim 4 has been amended. Favorable reconsideration is requested in view of the above amendments and the following remarks.

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph, because the language “next-but-one” is allegedly unclear notwithstanding relevant explanatory portions of the disclosure previously pointed out by Applicant in the Response dated June 17, 2005. Applicant respectfully maintains that when read in the context of the disclosure, one of ordinary skill would understand the meaning of the phrase “next-but-one.” However, for the purpose of advancing prosecution, claim 4 has been amended to recite “an adjacent filament end.” Accordingly, withdrawal of this rejection is requested.

Claims 1-4 and 6-10 stand rejected under 35 U.S.C. § 102(a) as anticipated by the “prior art” stent join arrangement shown in Figure 3 and described in Figure 4 because the “prior art” stent allegedly shows filament ends that are fixed together by placing the filaments over one another and placing them adjacent to and substantially parallel to one another.

Applicant respectfully disagrees. The Figure 3 “prior art” stent does not show filaments placed substantially parallel to one another. One of ordinary skill would understand the term parallel, particularly when read in view of Applicant’s disclosure to mean of, relating to, or designating two or more straight coplanar lines that do not intersect. Contrary to this meaning,

the “prior art” stent of Figure 3 embodies pairs of filament ends that are fixed together by placing the filaments over one another and twisting each filament end around the other, thereby resulting in multiple points of intersection.

The stent of the present invention is mechanically biased towards a first radially expanded configuration in which it is unconstrained by external forces, and can be retained in a second radially compressed configuration.

Referring to page 11 of the specification, lines 23 *et seq.*, Figs. 3 and 6 show two alternative joints in accordance with the claimed invention. As shown in Fig. 3, the filaments 3 may be joined with a weld which forms bead 8, or as shown in Fig. 6, may be joined without a bead.

As can be seen from Fig. 6, joins 8 extend outward radially from the main body of the stent, and filaments 3 are shaped so that the angle at which join 8 bends outward increases (preferably by 10 to 15°) as the filaments extend towards join 8.

Figure 4 evidences the surprising benefits conferred by Applicant’s join configuration as compared to the prior art twist arrangement. More specifically, the data shows that a stent comprising join arrangement which embodies filament ends in substantially parallel alignment is significantly better in the amount of failures. Further, as discussed at page 2 of the disclosure, a stent having a design in accordance with the present invention allows its ends to deform elastically during compression and expansion as the strain created by such forces are redistributed over the section of the braid that is adjacent to a joined end. Accordingly, fixed ends remain intact and the problem of unraveled and splayed ends following deployment

observed in the prior art, is thereby overcome. A twisted arrangement does not allow for this redistribution of stress. In a twisted filament arrangement, filament wires may break at the twists, or twisted ends may break off completely.

The Figure 3 “prior art” stent relied upon by the Examiner does not teach filaments that are fixed together by placing filament ends over one another and placing them adjacent to and substantially parallel to one another. Accordingly, the rejection of claim 1 under §102(a) is traversed. The rejection of claims 2-4 and 6-10 is traversed at least by virtue of their dependency on claim 1.

On page 2 of the Action, the Examiner relies upon the “prior art” stent shown in Figure 3 and described in Figure 4 to anticipate or render obvious the features of the invention recited in the dependent claims. Specifically, the “prior art” stent is relied upon to assertedly teach filaments that are biased out of alignment with the adjacent filament, as in claim 2, and a shoulder in a rearward axial direction due to the bead having a diameter which is larger than the diameter of the wire, as in claims 3, 4, 6 and 8. With regard to claim 10, it is asserted that the filaments of the prior art stent are parallel to each other at the helical twisted area and are therefore joined at an angle of zero degrees. However, as noted above, claims 2-4, 6, 8 and 10 are not anticipated by virtue of their dependency from claim 1. In addition, Applicant respectfully submits that the stent shown in Figure 3 does not show fixed ends that are shaped or heat treated to urge the respective filaments to a position in which they are biased out of alignment with the adjacent filament to which they are connected. The stent relied upon shows a

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simple twisting arrangement. Further the stent relied upon does not show a range of angles at which filaments may be joined together, or the other features of the dependent claims.

Claim 5 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over “Applicant’s Disclosure.”

The Examiner has recognized that the “admitted prior art” fails to disclose some but not all of the filaments being welded, but contends that it is old and well known to weld only some of the filaments of a stent and concludes that it would have been obvious to construct the admitted prior art stent with only *some* filament pairs welded. The Examiner contends further, that the above “well known in the art statement” is taken to be admitted prior art because Applicant failed in the previous Response, to traverse the Examiner’s assertion.

Applicant also respectfully traverses this rejection.

First, the Examiner has provided no reference that shows that it is old and well-known to weld only some of the filaments of a stent. The Examiner has not provided adequate evidence to support his conclusion. If the Examiner persists, he is requested to supply an affidavit to support his position that it is old and well-known to weld only some of the filaments of a stent. Further, the Examiner has not identified any motivation to modify the stent disclosed in the specification to arrive at the invention recited in Applicant’s claims 5 and 12.

Still further, Applicant disagrees with the contention that the “well known in the art statement” may be taken to be admitted prior art. Applicant respectfully submits that in the previous Action, the Examiner’s decision to take “official notice of a fact unsupported by documented evidence” was not clearly and unmistakably identified, as is required by the Patent

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Office. *See* MPEP §2144.03 (B). Thus, to the extent that it may have been unclear to the Examiner, Applicant herein clarifies that it is not old and well-known in the art to construct a stent with only *some* filament ends welded in the context of the present claimed invention, and requests that the Examiner point to evidence in the art for this teaching.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Applicant's Disclosure in view of U.S. Patent No. 5,061,275 to Wallsten et al. On page 3 of the Action, it is recognized that the admitted prior art fails to disclose filaments bending outwardly. Accordingly, Wallsten et al. is relied upon for the assertion that this teaching would be obvious to one of ordinary skill.

Applicant also respectfully traverses this rejection.

Wallsten et al. does not rectify the deficiencies noted above with regard to the "prior art" stent disclosed in the specification.

Further, no motivation or suggestion to combine Wallsten et al with the alleged "admitted prior art" has been presented and for this reason too, the rejection of claim 11 under §103 is traversed. The Examiner is required to have presented some motivation, suggestion, or teaching of the desirability of making the specific combination featuring all of the elements of the combination that was made by the applicant. *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). Any suggestion or motivation to combine "admitted prior art" references, must either explicitly or implicitly be found in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01 citing *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

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Still further, the Examiner is required to show how and why the Applicant would have been motivated to combine any alleged references in the manner combined by the Examiner. “[T]he examiner must present a convincing line of reasoning” for a proper conclusion that an invention is obvious in view of prior art. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). *See also, Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Here, the Examiner has not done so.

Because the Examiner has not made clear any specific understanding or principle within the knowledge of a skilled artisan that would motivate or suggest to one with no knowledge of Applicant’s stent arrangement to make the arrangement, Applicant submits that the Examiner used impermissible hindsight reconstruction in reaching the conclusion of obviousness.

The outstanding rejections under 35 U.S.C. §103(a) should therefore be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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